

**REMARKS**

Claims 1, 6, 8, 9, 10, 11, 16, 20, 29, 30, 31 and 32 have been amended and new claims 41-44 have been added. Generally, the independent claims have been amended to clarify that an object associated with a calendar entry in a file of an electronic calendar is stored and that the searching mechanism is configured to search a resource other than the file in which the object is located. New claims 41-44 recite providing a hyperlink and means for providing a hyperlink.

**Oath/Declaration**

The records of applicant's representative indicate that the post office address of inventor No. 3 (K. Forbes) is the same as her residence address.

**Claim Objections:**

The Examiner objected to claims 6 and 16 as they depended from cancelled claims. In response, these claims have been amended to depend from claims 1 and 11 respectively. The objection is therefore overcome.

**35 USC 102(b)**

The Examiner rejected claims 1, 3-6, 8-11, 13-16, 20-22 and 29-34 under 35 USC 102(b) as being anticipated by Vora et al. (US Patent No. 5,623,652)

Regarding claims 1, 8-11, 20 and 29-32, the Examiner states that "Vora discloses an apparatus and method for associating information with an object in a file (fig. 2, block 201), the apparatus comprising a scheduler (fig. 7B, items 727 and 729) including a component for associating a search key (fig. 7B, keys 726 and 733 and 735) with the object in the file by tagging the object (fig. 6, box 615 and col. 15, lines 20-27), wherein said scheduler is operable to schedule a search for said information using said search key for automatic execution at a pre-scheduled time (fig. 7B, key 726 with 735) by a search interface operable to initiate a pre-scheduled search (fig. 7B), and associating a search result with the tag (fig. 6, 617)."

Claim 1, has been amended to add the underlined wording as follows:

1. (Currently amended) A method of associating search information with an object in a file of an electronic calendar, the method comprising:
  - a) storing an object associated with a calendar entry in a file of an electronic calendar;
  - b) associating a search key with the object, in said file by tagging the object with a tag;
  - c) scheduling a search for said search information using said search key to search resources other than the file of the electronic calendar, for automatic execution at a pre-scheduled time by a searching mechanism;
  - d) initiating a pre-scheduled search by said searching mechanism, at said pre-scheduled time to produce a search result in response to said search key;
  - e) associating said search result with said tag, in said file.

Vora et al fail to disclose or suggest a method of associating search information with an object in a file in which an object associated with a calendar entry in a file of an electronic calendar is stored and a searching mechanism configured to search a resource other than the file in which the object resides.

The Vora system appears to be a system in which a user launches a client searching application, selects a searching server, creates a new search request, selects resources to search and causes the search to begin. The results of searches are displayed in a search window as a list of documents and the user can select one of the documents on the list for viewing.

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Searches can be scheduled for later execution, if desired, to search the database after the database has been updated.

The client searching application of Vora is an application specifically for searching. It is not an electronic calendar as claimed in applicant's claims and there is no suggestion to provide a method of searching information in connection with an electronic calendar. More specifically Vora fails to disclose or suggest storing an object associated with a calendar entry in a file of an electronic calendar as recited in applicant's claim 1.

Applicant respectfully submits that in many respects the Examiner's comparison of the Vora reference to applicant's claim 1 is improper.

#### Search Key

The first improper comparison relates to the term "search key" in applicant's claims. In different parts of the official action the examiner has equated both the collection of items 726, 733 and 735 of Vora and the index of Vora with the applicant's term "search key" but neither can properly be equated. Items 726, 733 and 735 of Vora are selector buttons for selecting automatic searching, selecting searching only when requested and for entering a search schedule. These items are not a "search key" as recited in applicant's claims and as would be understood by one of ordinary skill in the art to be what are also known as keywords for searching, rather they appear to relate to scheduling a search and are thus not equivalent to the "search key" recited in applicant's claims. Scheduling is differentiated from the search key in applicant's claims by being separately recited. Thus, elements of Vora that related to scheduling cannot properly be equated with a search key.

The Examiner also equated applicant's term "search key" with the "index" of Vora. The index of Vora cannot be equated to the search key because the indexes referred to in Vora appear to be those that correspond to the dictionary definition of an index, namely a list of documents arranged in an order of some specified datum such as author. Having regard to the

paragraph above in connection with what is meant by the term "search key" in applicant's claims, the index described by Vora cannot properly be said to be a search key.

#### File

The second improper comparison relates to the Examiner's equating the "file" recited in applicant's claims to the "data searched" by Vora. The Examiner has taken the position that Vora discloses the object (search request) in said file (data searched) (O.A., p. 5, last line). The claims now clearly recite that the file is a file of an electronic calendar and that resources other than the file of the electronic calendar are searched. Thus, in the applicant's claims, the file in which the object with which the search key is associated is a calendar file and the resources that are searched by the searching mechanism are resources other than the file of the electronic calendar. Consequently the file recited in applicant's claims cannot be equated with the with the data searched by Vora.

#### Tagging

Another improper comparison relates to tagging. Vora provides no disclosure of tagging the object with a tag to associate a search key with the object, as recited in applicant's claims. The Examiner refers to Figure 6, box 615 and column 15, lines 20-27 of Vora as describing tagging the object. Figure 6 of Vora is a flowchart describing a typical embodiment of a method for scheduling searches and generating reports of those searches in a summary format. Box 615 includes the language "update the index for selected Information sources to reflect new (or modified) information In this information source(s) indexes labeled with last modified date. Column 15, lines 20-27 of Vora recite: "The addition of new or modified information in the information sources requires, in those searching systems which use indexing before searching, that the new information be indexed to reflect the newer modified information; these indexes are labeled with a date showing when they were last changed and each document which has been indexed is also saved so that the system will know which documents have been indexed and which

have not." In summary it appears indexes are updated, i.e. lists are updated, and labeled with a new date. It is not clear what the Examiner regards as a tag, or tagging.

As best understood, the Examiner appears to regard the date showing when an index was last updated as a tag, but the date described by Vora is not a tag. The term "tag" would be known to one of ordinary skill in the art to be a device used to invoke a function in a markup language. A mere date is not known to invoke a function and thus would not be regarded as equivalent to a tag. A date cannot associate a search key with the object, as recited in applicant's claims. Furthermore the date that appears to be regarded by the Examiner as a tag appears to be associated with an index and there is no disclosure or suggestion that the index or date is in the file containing the object, where the file is a calendar file and where the file is a resource other than that searched by the searching mechanism. Consequently, Vora discloses nothing that would correspond to a tag or associating a search key with the object by tagging the object with a tag, as recited in applicant's claims.

The Examiner also refers to Figure 6 item 617 for the language "associating said search result with said tag, in said file." Block 617 of Figure 6 includes the language "scheduled search request, at scheduled time(s), searches updated index for new (or modified) information (for a document matching search parameters, compare documents "last modified date" to date of last scheduled search (or if 1<sup>st</sup> scheduled search, date of creation of scheduled search request); update report prepared. The related disclosure appears at column 15, lines 34-42 which states: "In step 617 which shows the one embodiment, the scheduled search request at the scheduled time causes performance of a scheduled search through the updated index for new documents which match the search parameters and which have last modified dates which are subsequent to the date that the search scheduled request was created in the case of a first scheduled search or subsequent to the last

scheduled search. This also causes a report to be generated listing the documents found by the scheduled search request."

From the foregoing, if the generated report is the search result, it is not clear where in the above passage or in block 617 there is a disclosure or suggestion that this result should be associated with a tag. Again, there is nothing in Vora that would correspond to the tag recited in applicant's claims.

Put simply, in applicant's claim 1, the tag associates a search key with the object and the search results are associated with the tag. The tag must be in the same file as the object and the searching mechanism is configured to search a resource other than the file in which the object and the tag are located.

#### Conclusion re 35 USC 102(b)

From the foregoing, it has been shown that certain items the Examiner relies on as being equivalent to the elements of applicant's claim 1 are not equivalents. These arguments, together with the amendments herewith more clearly point out the distinction between Vora and applicant's claimed invention. In summary, Vora fails to disclose or suggest either explicitly or implicitly the subject matter recited in claim 1 and therefore, the rejection of claim 1 under 35 USC 102(b) is overcome.

Independent claims 8, 9, 11, 20, 29, 30, 31 and 32 have been amended in a manner similar to claim 1. Therefore, the rejections of these claims under 35 USC 102(b) are overcome for the same reasons as claim 1.

Regarding claims 3, 4, 13 and 14, it has been explained above that Vora does not disclose tagging or a tag and therefore for this reason and for the additional reasons given in connection with the independent claims from which they depend, the rejection of these claims under 35 USC 102(b) is overcome.

Regarding claims 5, 6, 15, 16, 21, 22, 33 and 34, the rejection of these claims is overcome due to their ultimate dependence upon one of the above independent claims for which the rejection has been overcome.

35 USC 103(a)

Claims 23-28 and 35-40 are rejected under 35 USC 103(a) as being unpatentable over Vora et al (US 5,623,652) in view of Stark (US Patent No. 5,935,210). The Examiner states that Vora discloses all of the subject matter of claims 20 and 32, (from which claims 23-28 and 35-40 respectively ultimately depend), but Vora does not expressly teach a search associated with a universal resource locator (URL). The Examiner further states that Stark discloses mapping structure where a URL is associated with a search object.

Arguments showing the differences between Stark and applicant's claimed invention have been given in previous responses. In response, the Examiner has indicated he regards Vora as a searching system that uses pointers for searchable information (fig 2, item 205, Vora) and uses a server over the internet (fig. 1, Vora), and Stark is a mapping system concerned with creating and searching URLs (abstract, Stark). The Examiner also alleges both systems search the internet, and since searching the internet was common and notoriously well known at the time the invention was made, the Examiner alleges that Vora in view of Stark are clearly obvious when used in combination. Applicant respectfully submits the Stark system does not search the internet in the same manner as recited in applicant's claims. Stark employs a spider to scan HTML documents to determine links identified by other URLs within an HTML document, among other things. Stark searches sites, not the internet per se, to produce a resource map. Regardless, the fact that Stark searches sites, whereas Vora may search a resource available through an Internet, is not sufficient to motivate one of ordinary skill in the art to applicant's invention, nor is it sufficient to establish a prima facie case of obviousness.

The requirements for a *prima facie* case of obviousness have been well-established by the Court of Appeals for the Federal Circuit, and are concisely summarized in M.P.E.P. §§ 2142 and 2143, which confirm that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner has not shown there is anything in the references themselves that provide any suggestion or motivation to modify the reference(s) or to combine the teachings of the references. The Examiner appears to purport that there is some suggestion or motivation in the knowledge generally available to one of ordinary skill in the art, by the statement that searching the internet was common and well known at the time the invention was made, however it is not understood how knowledge that the internet could be used for searching would lead one of ordinary skill in the art to: *associate information with an object associated with a calendar entry in a file of an electronic calendar by: initiating a search for said information, through a resource other than said file, using a search key and an associated time of execution associated with said object by a tag associated with the object in said file and associating with said tag a result of said search, as recited in claim 20, for example, from which claim 23 ultimately depends.*

In particular, the knowledge the Examiner alleges was possessed by one of ordinary skill in the art fails to suggest the use of a tag in the context claimed, for example. Consequently, the knowledge relied on by the Examiner is insufficient to satisfy the first part of the test.

The second part of the test is also not satisfied because without any suggestion or motivation to modify or combine the teachings of the references or the knowledge generally available to one of ordinary skill in the art, there can be no expectation of success.

The third part of the test is also not satisfied since all of the claim limitations cannot be found, even in the combination of references proposed by the Examiner. For example the tag recited in claim 20 has been shown above in connection with claim 1 as not being disclosed by Vora. The Examiner's premise that Vora discloses all of the limitations of claim 23, for example, except addressing a universal resource locator (URL) associated with said search engine is flawed because not only does Vora fail to disclose the addressing step directly recited in applicant's claim 23, but Vora also fails to disclose the tag and steps related thereto. Similar arguments apply to the remaining claims rejected under this heading.

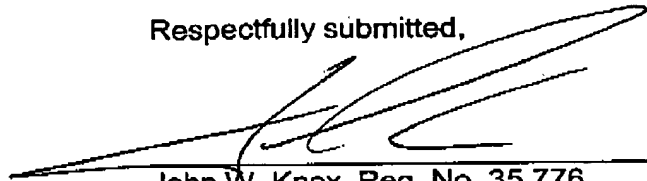
In view of the above, applicant respectfully submits the Examiner has not established a prima facie case of obviousness and therefore the rejection of claims 23-28 and 35-40 under 35 USC 103(a) is improper and has been further overcome by the amendments to claims 20 and 32, from which these claims ultimately depend.

Applicant respectfully requests further, favorable consideration of this case in light of the amendments herewith and the arguments above. Should the Examiner be unpersuaded by the above remarks, and find it necessary to repeat the rejection, applicant respectfully requests that the Examiner clearly and concisely indicate what he regards in the cited references corresponds to an object, a file, a search key, tagging, a tag, a search, a resource other than said file, a search result and associating said search result with said tag, as recited in applicant's claim 1, for example, so that there is no ambiguity as to how the Examiner is construing these terms, and to clearly show that all aspects of applicant's claims are being considered.

Applicant herewith petitions for an automatic extension of time for one month, from **May 25, 2004** to **August 25, 2004**, for responding to the outstanding Office Action dated February 25, 2004.

The Director is hereby authorized to charge the extension of time fee in the amount of **\$950.00** to Deposit Account No. **06-0713**.

Respectfully submitted,



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